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09/252,034	02/18/1999	SATOSHI HOSHINO	WN-1979	3994

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EXAMINER

AHMED, SAMIR ANWAR

ART UNIT	PAPER NUMBER
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2623

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18

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 18

Application Number: 09/252,034

Filing Date: 02/18/1999

Appellant(s): Satoshi HOSHINO

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Thomas W. Perkins

For Appellant

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**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 6/21/2002.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is deficient because the paragraph started on page 4, line 19 and ended on page 5, line 11 of the brief is not consistent with and does not exist in the originally filed specification.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 8-25 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

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4,025,748

Filip

5/24/1977

Japanese Patent 63-5551

Yasaku

1/14/1988

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 8-19 and 20-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The grounds for rejections stated in paragraph 3 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by reference herein.

***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The grounds for objection stated in paragraph 4 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by reference herein.
4. The amendment filed 12/21/01 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "Figure 7 shows the projected portion 6b below the recessed

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portion 10a under the influence of surplus pressure” (second paragraph beginning on line 15 on page 9).

Applicant is required to cancel the new matter in the reply to this Office action.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 20-24, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuyashi Yasaku [Japanese Patent No. 63-5551] in view of Filip (U.S. Patent 4,025,748).

The grounds for rejections stated in paragraph 6 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by reference herein.

As to claim 20 [as best understood by the Examiner], refer to claim 20 rejection stated in paragraph 6 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by reference herein. Filip further discloses that the electrical contacts are closed when the switch is locked (i.e., the switch is activated only in the lock position) (col.2, lines 45-55).

As to claims 21-24, and 8, refer to claim 21-24 and 8 rejections stated in paragraph 6 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by reference herein.

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuyashi Yasaku [Japanese Patent No. 63-5551] in view of Filip (U.S. Patent 4,025,748) as applied to claim 24 above and further in view of Murata (U.S. Patent 4,642,433). The grounds for rejections

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stated in paragraph 7 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by reference herein.

8. Claims 9-10, 12-16, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuyashi Yasaku [Japanese Patent No. 63-5551] in view of Filip (U.S. Patent 4,025,748) as applied to claim 20 above and further in view of Itsumi et al (U.S. Patent 5,559,504). The grounds for rejections stated in paragraph 8 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by reference herein.

9. Claims 17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuyashi Yasaku [Japanese Patent No. 63-5551] in view of Filip (U.S. Patent 4,025,748) in view of Itsumi et al (U.S. Patent 5,559,504) as applied to claims 16 and 18 above and further in view of Heinz Lubke (DE 29 52 212). The grounds for rejections stated in paragraph 9 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by reference herein.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuyashi Yasaku [Japanese Patent No. 63-5551] in view of Filip (U.S. Patent 4,025,748) as applied to claim 20 above and further in view of Tsikos (U.S. Patent 4,353,056). The grounds for rejections stated in paragraph 10 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by reference herein.

**(11) Response to Argument**

Appellant's arguments filed 6/21/02 have been fully considered but they are not persuasive with regard to claims 8-25 for the following reasons:

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***35 USC § 112, first paragraph Rejections:***

Appellant alleges that “when one of skill in the art considers the sequence of events shown in Figures 1 and 2, the extension of the holder 10 below the detent position, and the room for further movement of the contact surface 6 below the detent position, applicant contends that one of skill in the art would find it apparent that the contact surface must be able to move below the detent position in order to achieve the goal of reducing pressure variation” (page 6, line 20- page 7, line 6). The Examiner disagrees. Firstly, Figs 1 and 2 are not detailed figures to show what Appellant claims. Secondly, the specification on page 8, lines 9-13 clearly recites “when the contact surface 6 is moved downwards until the projected portion 6b faces to the recessed portion 10a, the projected portion 6b and recessed portion 10a are engaged with each other and the contact surface 6 is locked (STEP 304)” (emphasis added). The word “locked” in any dictionary means “fixed in position”. Fig. 3 shows step 303 which states “STOPPER PORTION 8 FIXES CONTACT FACE 6” i.e. the surface is fixed in place. Furthermore Fig. 3 does not show or suggest the contact surface 6 moves any further after it is locked in step 303 and in step 304 the switch is “on” to extract the fingerprint image.

Appellant alleges that “Indeed, if the contact surface could not move below the detent position, the device would not achieve this goal because the user could apply too much pressure with impunity. There would be no way to prevent the application of too much pressure [.]” (page 7, lines 6-12). The Examiner disagrees. The specification on page 9, lines 15-17 recites “a click impression or a feeling of engagement from the lock mechanism 8 can inform the user whether the pressure of the fingertip is sufficient or not, and on lines 21-22 recites “Thus, the click impression notifies the user of unnecessary of pushing the contact surface 6 any more”. It is

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clear that the device achieves this goal by generating a click impression from the lock mechanism, notifying the user of unnecessary of pushing the contact surface 6 any more, and not by moving the contact surface below the detent position .

Appellant alleges that “If the contact surface 6 were not to move below the detent position, why not simply place a stop to prevent further movement (e.g. bending the holder into an L-shape at the detent position or providing a floor). The applicant shows that extension of the holder [,]” (page 7, line 16-page 8, line 9). The Examiner disagrees. The extension of the holder 10 below the detent position and the room for further movement of the contact surface 6 below the detent position shown in Figs 1 and 2, does not necessarily convey to one of ordinary skill in the art that the contact surface 6 must move below the detent position, for the following reasons:

(1) The specification on page 8, lines 9-13 and Fig. 3 as discussed above disclose that the contact surface 6 is LOCKED at the detent position which teaches away from the notion of further movement of the contact surface 6 below the detent position.

(2) If the contact surface 6 is permitted to move below the detent position, when it is pushed too much further down, it could reach the end of the extension of the holder 10 below the detent position and breaks loose, simply because there is no stop at the end of the extension of the holder 10. When this happens the holder 10 which includes a leaf spring which is bent easily (see specification page 7, lines 4-5) would move inwards and lean on the top of the contact surface 6 and remain in that position and the system becomes inoperative. Indeed the absence of a stop mechanism at the end of the extension of the holder 10 would not convey to one of



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ordinary skill in the art that the contact surface 6 must move below the detent position because of the above scenario. If anything, it conveys exactly the opposite.

(3) The specification on page 7, lines 7-10 clearly recites “the contact surface 6 is slid into the recessed portion 10a of the holder 10 and makes the projected portion 6b engaged with the recessed portion 10a (Fig. 2) in order to fix the contact surface 6 to the holder 10”.

Appellant alleges that “ The Examiner, in his Official Action of March 4, 2002 (page 4, line 3), misinterprets this paragraph. He states that the user stops pushing [.]” (page 9, lines 1-13). The Examiner disagrees. The Examiner stated in that Office Action on page 4, that the click impression informs the user not to push anymore which is in line with the specification which recites on page 9, lines 15-17 recites " a click impression or a feeling of engagement from the lock mechanism 8 can inform the user whether the pressure of the fingertip is sufficient or not, and on lines 21-22 recites “ Thus, the click impression notifies the user of unnecessary of pushing the contact surface 6 any more”. Furthermore it is not true that if the user stopped pushing, the contact surface would rise and there would be no fingerprint impression to be made, simply because when the click impression is generated, the contact surface is already locked and cannot rise and the click impression notifies the user of unnecessary of pushing the contact surface 6 any more as explained above.

Appellant alleges that “ The Examiner also states that this paragraph is not concerned [.]” (page 9, lines 14-20). The Examiner disagrees. The Examiner in that Office Action stated “The paragraph of lines 15-24 on page 9 as explained above is concerned with generating a click

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impression and is not concerned with avoiding a click impression when the pressure is too high (as the Applicant argues)”.

Appellant alleges that “ The use of the term “lock” in the application does not imply a fixing position. One of skill in the art reading the entire application [.]” (page 10, lines 18-22). The Examiner disagrees. The specification clearly discloses a lock mechanism that locks the contact surface as shown above by the different recitations on pages 7, 8 and Fig.3. Apparently, Appellant is now attempting to give a meaning to the term “lock” a definition repugnant to its standard meaning.

Accordingly, for the reasons given above, the contact surface does not move below the detent 10a. The specification does not describe the subject matter of claim 20 in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

***35 USC § 103 Rejections:***

As to claim 20, the Appellant alleges that “the switch in FILIP is for snowmobiles [.]” (page 13, last line- page 14, line 20). The Examiner disagrees. Firstly, FILIP clearly states that the switch is not exclusively for application on vehicles (col. 1, lines 18-19) and a switch can be employed in any environment. Secondly, Filip discloses that if the button 30 is depressed (i.e. the button is pressed the first time and is locked) then pressing the actuating end of the button with the finger which releases the button from the lock position (col. 3, lines 47-52). Thirdly, as recited in the specification the switch is an “on” “off” switch to trigger the CCD camera (see Fig. 3, steps 304, 305). There is no disclosure of any sensitivity requirements to both over and under pressure is recited any where in the specification, and the Examiner position is that any

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conventional "on" "off" switch would work to trigger the camera. Fourthly, the Examiner indicated the motivation, in the Official Action of March 4, 2002 (page 5, lines 17-19) that one of ordinary skill in the art would replace Yasaku's fingerprint switch with Filip's switch which has a simple mechanism for effecting the locking and unlocking of the switch in order to lock the device when the pressure by the finger on the contact surface of the sensor is sufficient to reach the locking position and acquires undistorted image of the fingerprint that makes it easy to accurately execute collation of the fingerprint..

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Samir Ahmed

7/12/2002



**SAMIR AHMED**  
**PRIMARY EXAMINER**

Conferees:



Amelia Au



Joseph Mancuso